

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1, 6-8, 10-24, 26-27, 30-31 and 33-36 are pending. Claims 2-5, 9, 25, 28-29 and 32 are cancelled. Claims 16-23 have been withdrawn. Claims 1, 6-8, 10-15, 24, 26-27, 30-31 and 33-36 are under consideration. Claims 1, 6, 7, 24, 33 and 34 are amended.

II. Support for Amendments to the Claims

Applicants have amended claim 1 to replace the term “localizing an antibody-metal chelate complex to a desired tissue by administering a macrocyclic metal chelate” with “treating a subject with cancer”. Support for this amendment is provided in claim 1 as originally filed.

Applicants have incorporated the term “substituted or unsubstituted DOTA” from claim 5 into claim 1. Claims 6, 7 and 24 are also amended to incorporate this term.

III. Claim Rejections Under 35 U.S.C. § 112, first paragraph, written description

Claims 1-4, 10-15 and 28-29 are rejected on pages 2-6 of the Office Action under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 2-4 and 28-29 are cancelled. Applicants traverse the rejection by noting that DOTA is described in the application in Example 3. Applicants respectfully request withdrawal of this rejection.

IV. Claim Rejections Under 35 U.S.C. § 112, first paragraph, enablement

Claims 1-8, 10-15 and 24-29 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 2-5, 25, 28-29 and 32 are cancelled. Applicants traverse the rejection by noting that the use of DOTA is described in the application in Example 3. Applicants respectfully request withdrawal of this rejection.

VI. Claim Rejections Under 35 U.S.C. § 102

To maintain a *prima facie* case of anticipation, the Examiner must demonstrate that each and every element as set forth in the claim is either expressly found or is inherently described in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ...claim. See MPEP § 2131. Applicants submit that each element of the claims now pending has not been identified in the art presently of record. Therefore, Applicants respectfully traverse the following rejection.

Under § 102(b) over Hansen II

Claims 1-8, 10-15 and 24-29 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hansen, *et al.* (WO 99/66951) ("Hansen II"). Hansen II is cited by the Examiner for teaching a method of treating cancer in a subject by, among other things, administering an antibody that recognizes a targetable conjugate.

Hansen II is similar to the Hansen reference (US 2002/0006379, 1/17/2002) cited in a previous Office Action. As in the first Hansen reference, the targetable conjugate in Hansen II is a DOTA chelate with a peptide side chain. While Hansen II's antibody recognizes a targetable conjugate, the antibody is only recognizing a peptide sequence on the conjugate, and not the macrocyclic metal chelate itself. Therefore, any chelate, or any other molecule, could replace the macrocyclic metal chelate on Hansen II's targetable conjugate and binding would be the same, so long as the peptide side chain is not manipulated or interfered with. Therefore, Hansen II is missing Applicants' element of an antibody that "recognizes a macrocyclic metal chelate". Since all the elements of the Applicants' invention are not present in Hansen II, the anticipation rejection cannot be maintained.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-442-1000.

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PATENT

Respectfully submitted,



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